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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,806	10/16/2003	Bryan V. Hunt	86266AJLT	9649

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EXAMINER	
CHEA, THORL	
ART UNIT	**PAPER NUMBER**
1752	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/686,806	HUNT ET AL.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10152004;10162003*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for "the value for b*" in claims 1, 6, and "the CIELAB color system" in claim 7. Moreover, the claiming of b* is indefinite for failing to provide the definition associated therewith.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-2, 4-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Van Ackere et al ('442) or Weidner et al ('657).

The '657 and the '442 patents discloses a photothermographic material containing binder, photosensitive silver halide an non-photosensitive source of reducible silver ion and reducing agent as claimed in the present claimed invention. Note to the '442 patent in columns 24-26, claims 7-11, the blue dye in column 23 and the value of –B* of 16.62 in column 18, lines 13; the '657 patent, columns 33-48, claims 1-16; the use of tinting dye to adjust L*, a* and b* value in column 2, lines 21-60. The '657 and '442 patents may not stated specifically that "the value for b* at an optical density of 1.0 is greater than the value of b* at Dmin" presented in the claimed invention. However, the b* value is related to the material after processing. This value would be inherent to the material of taught '442 and '657 patent because of the similarity of the composition. In the absence of showing otherwise, it is asserted that the invention as claimed is either anticipated or found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Van Ackere et al ('442) or Weidner et al ('657) as applied to claims 1-2, 4-8 above, and further in view of Murray. The process having steps presented in the claims invention is taught in Murray in column 23-24, claims 9,19. it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to develop the material taught in the '442 or '657 patents with a known process taught in Murray to provide the claimed invention.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Van Ackere et al ('442) or Weidner et al ('657) as applied to claims 1-2, 4-8 above, and further in view of Katoh. Katoh in column 16, lines 1-14 disclose to use a dye stuff to provide an absorbance of a photothermographic material at least 0.8 at the exposure wavelength. It would

have been obvious to the worker of ordinary skill in the art at the time the invention was made to adjust absorbance accordingly to the exposure light source, and thereby provide an invention as claimed.

8. Claims 9-11 are rejected under 35 U.S.C. 102(b) as anticipated by Murray (US Patent No. 5,705,324). See column 23, claim 29, which discloses a process comprising same steps and the material having same composition comprising photosensitive silver halide, non-photosensitive silver salt, a reducing agent and a binder. The value of b* is related to the property of the after the image forming process, and it would be inherent to the material of Murray after development. There is no difference in the composition and the process as claimed, and the invention as claimed lacks novelty.

9. Claims 1-3, 5-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Toya et al (US Patent No. 5,998,126). See the photothermograohic material of Toya et al in column 34, claims 1, 4, 9-19, and columns 27-33. The material having same composition and has absorbance of 0.3 –1.2 at the exposure wavelength which encompasses the scope of absorbance of at least 0.6 at the exposure wavelength claimed in claim 2, 3. The b* claimed in the present invention is related to the property of the material after light exposure and heat developable. It depends not only to the material per se, but to the process of forming an image. Because of the similarity of the composition, this property would have expected from the material and process taught in Toya et al. Accordingly, the material as claimed is either anticipated by or found prima facie obvious over Tota et al.

10. Claims 1, 4 are rejected under 35 U.S.C. 102(b) as anticipated by Winslow et al (US Patent 5,891,615). See the material in the abstract which contains a sulfur-containing chemical sensitizing compound and the exemplified samples in columns 27-50, examples 1-34. The b* value claimed in the present invention is related to the property of the material after light exposure and heat developable. It depends not only to the material per se, but to the process of forming an image. This value would be inherent to the material of Winslow et al because of the similarity of the composition. Accordingly, the claimed material lacks novelty.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murray (US Patent No. 5,705,324) as applied to claims 9-11 above, and further in view of Manian (US Patent No. 5,172,419). The method of digitizing a medical film image has been known in Manian. See abstract and columns 6-10, claims 1-12. it would have been obvious to use a known image such as medical film image in the process taught in Murray , and thereby to provide a process as claimed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1700.

Tch tlh
December 20, 2004

Thorl Chea
Primary Examiner
Art Unit 1752